

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Raymond E. Clark et al.) Group Art Unit: 2625
Serial No.: 10/810,143) Examiner: Saeid Dehhkordy Ebrahimi
Filing Date: March 26, 2004)
Title: Optimizing Techniques During Processing of Print Jobs

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Arlington VA 22313-1450

AMENDMENT TO OFFICE ACTION

In response to the Office Action mailed on June 19, 2009, Applicants respond as follows:

In the outstanding Office Action, claims 1-20 and 27-35 are subject to another restriction requirement. The Office Action identifies Group I as being directed to claims 1-11; Group II as being directed to claims 12-20; and Group III as being directed to claims 27-35. In response, Applicants elect Group II, corresponding to claims 12-20 for prosecution in the present application, with traverse.

It is undisputed that in order to impose a restriction, an Examiner must prove that such restriction is warranted. Every requirement to restrict has two aspects: (A) the **reasons (as distinguished from the mere statement of conclusion)** why each invention as claimed is either independent or distinct from the others; and (B) the **reasons why there would be a serious burden** on the Examiner if restriction is not required. MPEP 808 (emphasis added). Examiners **must** provide reasons and/or examples to support conclusions. MPEP 801(I) (emphasis added). A mere statement of conclusion is inadequate. MPEP 808.01. A combination and subcombination are distinct if it can be shown that a combination as claimed: A) does not require the particulars of the subcombination as claimed; and B) the subcombination can be shown to have utility by itself or in another materially different combination. MPEP 806.05(c). In presenting the reasons why there would be a serious burden on the Examiner if the restriction is not required, the Examiner **must show by appropriate explanation** one of the following: (A) separate classification thereof; (B) a separate status in the art when the inventions are classified together; and (C) a different field of search. MPEP 808.02 (emphasis added).

Concerning MPEP 808(A)

Groups I-III are identified in the outstanding Office Action as being related as combination and subcombination. In the Office Action, it is contended that “the combination as

claimed does not require the particulars of the subcombination as claimed because, the combination has separate utility.” First, Applicants respectfully submit that the outstanding Office Action fails to identify which group of claims is the combination and which groups are the subcombinations. Applicants are not aware how distinct inventions can be shown without first identifying which group is the combination and which are the subcombinations. More importantly, however, is the requirement that reasons be provided instead of mere statements of conclusion. Here, the only showing are conclusions, i.e., that each of MPEP 806.05(c)(A) and (B) are met. Because only statements of conclusions are used to show distinctness, Applicants respectfully submit that requirement under MPEP 808(A) has not been established.

Concerning MPEP 808(B)

In the outstanding Office Action, there is no reason provided why there would be a serious burden on the Examiner if the restriction is not required. There is no showing of separate classification. In fact, no classifications are even provided. There is no mention of a separate status in the art or of a different field of search being necessary. By altogether ignoring the requirement clearly laid out in MPEP 808(B) and MPEP 806.05(c), the Examiner has failed to show a serious burden existing if the restriction is not required.

Due to the insufficiency in showing both that the two inventions are distinct and that there would be a serious burden on the Examiner if a restriction is not required, Applicants respectfully submit that the burden of proof under MPEP 808 has not been met and request that the restriction be withdrawn and all of the pending claims be prosecuted in the present application.

In reply to this present response, if the Examiner wishes to sufficiently prove that the restriction is warranted, the present restriction needs to be withdrawn and a new restriction entered having the necessary proof so as to give Applicants an opportunity to reply. Attempting to provide a level of proof after the fact in a subsequent action that makes the restriction final, without such proof first being in a restriction to which Applicants are able to respond, does not meet the requirements clearly stated under MPEP 808.

Applicants submit that in light of the foregoing remarks this application is in condition for allowance and early passage of this case to issue is requested. The Examiner is invited to telephone the undersigned in the event the Examiner would like to discuss the merits of the application or this Response.

If there are any other fees not accounted for above, the assignee of present application, Lexmark International Inc., hereby authorizes the Commissioner to charge any such fees, including any extension of time fees, to the account of Lexmark International Inc., Deposit Account No. 12-1213.

Respectfully submitted,

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